

### **Remarks and Arguments**

Applicants have carefully considered the Office Action dated November 9, 2004 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Applicants and their Attorney acknowledge the Examiner's indication of allowable subject matter as set forth in the objections to claims. Applicants have amended some of the claims objected to, however, regarding the remainder of the claims, applicants request that the examiner consider the arguments set forth herein.

Claims 8-9 and 17 have been rewritten in independent form, as suggested by the Examiner. Accordingly, claims 8-9 and 17 are now believed in allowable condition.

Method claim 18 has been amended to include limitation (F) of claim 19 and now recites "resolving the reference in a shadow document to one of the parent and child document" (claim 18, lines 13-14) and is believed allowable over any art of record whether considered singularly or in combinations. Claims 19 and 20 include all the limitations of claim 18 and are likewise believed in allowable for the same reasons as claim 18, as well as for their own respective merits.

Claims 1 and 11 have been rejected under 35USC section 101 as being directed to nonstatutory subject. Claim 1 has been amended to now recite the limitation of "storing the shadow document *in a computer readable memory*" (claim 1, line 7). Accordingly, claim 1 and its dependent claims 2-9 are now believed to overcome the examiner's rejection under 35USC section 101.

Applicants respectfully traverse the rejection of claim 11 under 35 USC section 101 as being directed to nonstatutory subject. For a considerable time now the USPTO has allowed claims in the form of "a computer data signal embodied in a carrier wave", the theory being that if computer program product claims are allowable why should the nature of the medium, i.e. tangible or intangible, make any difference. A search of the publicly accessible portion of the USPTO database ([www.uspto.gov](http://www.uspto.gov)) reveals that multiple United States patents issued since 1976 have issued in this form. Typical examples can be seen in the following US Patents and their respective claims:

6,112,240	Claims 38-48
6,131,121	Claim 12
6, 182,279	Claims 21-32
6, 185,184	Claim 14-16
6, 356,914	Claims 19-25

In light of the foregoing, if the examiner still has questions the examination guidelines published by the USPTO should be consulted.

Claims 1-7, 10-16 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6792145, Gay in view of U.S. Patent No. 5903646, Rackman. Applicants traverse such rejection on the grounds that the Examiner has failed to create a *prima facie* case of obviousness. In accordance with MPEP §2143.03, to establish a *prima facie* case of obviousness 1) the prior art reference (or references when combined) must teach or suggest *all* of the claim limitations; 2) there must be some suggestion or motivation to modify a reference or combine references; and 3) there must be a reasonable expectation of success.

In setting forth the rejection, particularly with regard to claims 1, 10-12, and 18, the Examiner has expressly admitted that Gay does not disclose the program code, program logic or techniques of creating a shadow document from an original document; identifying one of a parent and channel document of the original document; and storing a reference thereto in the shadow document team. Instead, the examiner is relying on Rackman to disclose such teachings.

Applicants respectfully assert that the prior art references do not teach or suggest *all* of the claim limitations. Specifically, the preamble's of each of claims 1, 10, 11, 12, and 18 recite any method, computer program product, computer data signal, apparatus, and method, respectively, for use with a computer system operatively coupled to a network and capable of *executing a communication process for sending and receiving electronic mail documents*. The Federal Circuit has routinely held that if the claim preamble, when read in the context of the entire claim, recites the limitations of the claim, or, if the claim preamble is "necessary to give life, meaning and validity" to the claim, then the claim preamble should be construed as if in the balance of the claim.

Pitney Bowes, Inc. v. Hewlett-Packard Co. , 182 F. 3d 1298, 51 USPQ 2d 1161 (Fed. Cir. 1999). The context of generating shadow documents and identification of parent/child relationships between the original document and the shadow document occurs in the context of an electronic mail communication process. Neither Gay nor Rackman disclose inventions to be implemented within the context of an electronic mail communication process. Gay discloses a system for extracting raw data from documents containing textual material while Rackman is a system for archiving and providing access to litigation documents. Neither reference specifically addresses the issues or objectives of the present invention which are intended for implementation in the context of electronic mail communications. Further, the examiner's Official Notice in rejecting claims 6-7 and 18, without further specifics or time references, does not remedy the deficiencies in Gay and Rackman.

In setting forth the rejections, the examiner is alleging that the disclosure in Rackman (column 8, lines 15-17) is analogous to the limitation of creating a shadow document from an original document, as recited in the claims. Applicants respectfully disagree with the Examiner's analogy. This section of Rackman merely discloses duplicating an original document. Conversely, in the present invention, the technique of creating a shadow document is not mere duplication but selective summarization, as described in the subject application in great detail (paragraph 41-42; Figs. 5A-B). The Examiner can appreciate that the inventive technique is fundamentally different the duplication described in Rackman.

The Examiner is further alleging that the disclosure in Rackman is analogous to the limitation of identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document. Applicants again respectfully disagree with the Examiner's analogy. This section of Rackman (column 8, lines 47-52) discloses linking among the scanned pages of an original document. Conversely, in the present invention, the technique of identifying one of a parent and child document involves sophisticated data structures and recursive algorithms to construct a conversation thread to which the parent/child documents belong, as described in the subject application in great detail (paragraph 40-45; Figs. 5A-6D). This technique is specifically designed for use with conversation threads in an electronic mail

environment. In the present invention, data maintained in a shadow document defines the parent/child relationships among original documents and their respective shadow documents. A new electronic mail message is considered a parent document and serves as the root from which a new shadow tree may be derived, as explained hereinafter. Any replies to the original electronic mail message is/are considered a child/children document(s). Within a conversation thread, and a hierarchical tree that represents such thread, children documents derive from a common root document. Accordingly, a parent/child tree hierarchy representing a conversation thread terminates at one extreme with a root document, or a shadow document thereof, and, at the other extreme, with one or more children documents, or shadows thereof, as the leaves of the tree. Neither Gay nor Rackman disclose such an invention.

Applicants further respectfully traverse the rejection of claims 1-7, 10-16 and 18 on the grounds that the Gay and Rackman references are not properly combinable. There is no teaching, disclosure, suggestion that the apparatus/ method taught in the Gay should be modified to include all or part of the teachings of Rackman or that their respective teachings be combined. The Examiner's statement regarding the rejection does not provide the required motivation as to why Gay and Rackman teachings would be combined. The Examiner will note that the motivation for the present invention is not to create a redundant data archive be retrieved in the event of primary system failure. Instead, as stated in the Background of the Invention section, the subject invention discloses a way to reconstruct conversation threads representing electronic mail document exchanges in a manner that may be rendered easily to provide a visual model of the conversation thread, and which can be efficiently stored in memory, even after the documents have been deleted. Neither Gay nor Rackman address these issues.

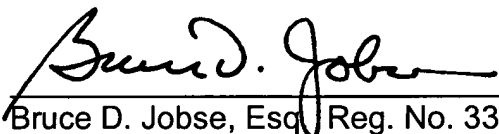
Accordingly, in light of the foregoing, applicants respectfully traverse the rejection of claims under 35 U.S.C. 103(a) on the grounds that the Examiner has failed to create a prima facie case of obviousness for failing to show how the prior art reference teaches or suggests all of the claim limitations and that there is no teaching motivation or suggestion to combine such references. (MPEP §2143.03).

Applicants respectfully traverse the use of Official Notice as grounds for rejection of claims 6-7 and 18, and, in accordance with The Manual of Patent Examining

Procedure section 2144.03, requests the Examiner to produce a reference in support of his assertion, or, alternatively, if such assertion is based on the personal knowledge of the Examiner, to provide Applicants with an affidavit averring to the specific facts supporting the personal knowledge on which the Examiner's statement is based. In taking a Official Notice, the examiner has not established that the claimed limitation(s) were disclosed in the alleged electronic-mail systems, such as Microsoft Outlook, as of the filing date of the invention.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. DA-12-2158.

Respectfully submitted,



Date:

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